UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte PETER CULLEN and ELIZABETH S. KAYE

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Appeal 2015-004481
Application 12/418,829
Technology Center 3600

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Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134(a) of the Final
Rejection of claims 1–5, 7–13, and 15–25 which are all the claims pending
in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention relates to processing electronically transmitted healthcare related transactions (Spec., para. 2). Claim 1, reproduced below with bracketed numerals added, is illustrative of the subject matter on appeal.

1. A computer implemented method comprising:

[1]   storing, by one or more switch provider computers, in memory, logic comprising one or more preset rules for implementing a value-add service on an electronic prescription transaction;

[2]   receiving, by one or more switch provider computers, from a healthcare provider system associated with a healthcare provider, the electronic prescription transaction, wherein the one or more switch provider computers are separate and remote from the healthcare provider system and any pharmacy system comprising one or more networked computers associated with a pharmacy or provider of a prescribed drug or product;

[3]   accessing, by the one or more switch provider computers from the memory, the stored logic;

[4]   determining, by the one or more switch provider computers from a plurality of value-add services, the value-add service to perform on the electronic prescription transaction, wherein the determining is based at least in part on information in the electronic prescription transaction and the stored logic;

[5]   editing the electronic prescription transaction by performing, by the one or more switch provider computers, the determined value-add service upon the electronic prescription transaction based at least in part on the stored logic, wherein the determined value-add service creates a modified electronic prescription transaction correcting an error in the information contained within the electronic prescription transaction; and

[6]   forwarding, from the one or more switch provider computers, the modified electronic prescription transaction to a

pharmacy system associated with a pharmacy specified in the electronic prescription transaction.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Rosenblum	US 2003/0050731 A1	Mar. 13, 2003
Henderson et al. (hereinafter "Henderson")	US 2003/0236683 A1	Dec. 25, 2003
Denny	US 2007/0162309 A1	July 12, 2007
Piovanetti-Perez (hereinafter "Perez")	US 2009/0198520 A1	Aug. 6, 2009

The following rejections are before us for review:

1. Claims 1–5, 7–13, and 15–25 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

2. Claims 1, 3–5, 7–9, 11–13, 15–19, and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Denny and Perez.

3. Claims 2 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Denny, Perez, and Henderson.

4. Claims 20–24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Denny, Perez, and Rosenblum.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.[1]

ANALYSIS

35 U.S.C. § 101

The Examiner has rejected claims 1–5, 7–13, and 15–25 under 35 U.S.C. § 101 (Ans. 2–4).

In contrast, the Appellants have argued that this rejection under 35 U.S.C. § 101 is improper (Reply Br. 2–10). The Appellants have argued that the claim is not directed to an abstract idea, that the claims recite more than generic computer functions, and that the claims avoid preemption and improve a technological process (Reply Br. 4-10).

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: "laws of nature, natural phenomena, and abstract ideas" are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014).

In judging whether claim 1 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court's two-step framework, described in *Mayo* and *Alice. Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97

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[1] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

(2012)). In accordance with that framework, we first determine whether the claim is "directed to" a patent-ineligible abstract idea. If so, we then consider the elements of the claim both individually and as "an ordered combination" to determine whether the additional elements "transform the nature of the claim" into a patent-eligible application of the abstract idea (*Id.*). This is a search for an "inventive concept," an element, or combination of elements sufficient to ensure that the claim amounts to "significantly more" than the abstract idea itself (*Id.*). The Court also stated that "the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention" (*Id.* at 2358).

Here, we find that the claim is directed to a method of organizing human activities in the concept of correcting errors. In this case, the method of correcting errors is directed to correcting errors associated with electronic prescription transactions and is a method of organizing human activities and an abstract idea beyond the scope of § 101.

The Appellants have argued that claim 1 is an improvement in the technological process of identifying and correcting errors in electronic prescription transactions electronically transmitted and processed over a network, such as the Internet (Reply Br. 4–6, 9–10). We disagree and find the claim is not rooted in technology but rather directed to the abstract idea of correcting errors associated with electronic prescription transactions in a conventional computer network environment. *See, e.g.*, Spec., para. 27 ("These network devices and systems may also include a processor for processing data and executing computer-executable instructions, as well as other internal and peripheral components that are well known in the art"); *id.* at para. 28 ("healthcare provider system 102, switch provider 104, and third

party system 108 may be in communication with each other via a network such as network 106, which, as described below, can include one or more separate or shared private and public networks, including the Internet or a publicly switched telephone network"). The invention does not solve a problem unique to the Internet or any other network or communication technology. Rather, the invention addresses a business need, namely "a need to provide clinical, administrative and/or financial value-add services to the healthcare service being provided, as well as provide clinical, administrative and/or financial messages related to the healthcare related transaction processing to healthcare providers, patients, pharmacists, and/or the like" (Spec., para. 5).

We note the point about pre-emption (Reply Br. 5–6, 8–9). While pre-emption "might tend to impede innovation more than it would tend to promote it, 'thereby thwarting the primary object of the patent laws'" (*Alice*, 134 S. Ct. at 2354 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012)), "the absence of complete preemption does not demonstrate patent eligibility" (*Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)). *See also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), cert, denied, 136 S. Ct. 701, 193 (2015)("[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.").

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the

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abstract idea using generic computer components. We conclude that it does

not. Considering each of the claim elements, both individually and as an

ordered combination, the function performed by the computer at each step of

the process is purely conventional. Although the method is nominally

"computer-implemented," each step of the claimed method does no more

than require a generic "one or more switch provider computers" to perform

routine computer functions ("storing," "receiving," "accessing,"

"determining," "editing," and "forwarding" information) that traditionally

have been provided manually. *Cf. OIP Techs.*, 788 F.3d at 1363 ("relying

on a computer to perform routine tasks more quickly or more accurately is

insufficient to render a claim patent eligible"). The Specification supports

the view that the computer implementation is entirely conventional. *See,
e.g.*, paragraph 31 of the Specification:

> The switch provider 104 (also referred to as the "switch")
> may include any processor-driven device that is configured for
> receiving, processing, and/or fulfilling healthcare related
> transactions from the healthcare provider system 102 or from a
> third party system 108. Such processor-driven device may be a
> server computer, a mainframe computer, one or more networked
> computers, a desktop computer, a personal computer, a laptop
> computer, a mobile computer, a handheld portable computer, a
> digital assistant, a personal digital assistant, a digital tablet, or
> any other processor-based device.

For these reasons, the rejection of claim 1 and its dependent claims is

sustained. Independent claims 9 and 17 are each directed to a generic

"system" comprising "at least one memory device" and "at least one

processor associated with one or more switch provider computers" that

performs the same concept as claim 1. Accordingly, the rejection of

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independent claims 9 and 17, and their corresponding dependent claims, is sustained for the same reasons.

35 U.S.C. § 103(a)

The Appellants argue, *inter alia*, that the rejection of claim 1 is improper because the Examiner has not shown that the prior art discloses limitation [5] of claim 1 (App. Br. 17–19). According to the Appellants, the portions of Perez cited by the Examiner teach sending the transaction back to the prescriber (healthcare provider) to let them review and correct the transaction (*Id.* at 25).

In contrast, the Examiner has determined that the above limitation [5] is found in Perez at paragraph 137 (Final Act. 5–6; Ans. 5–6). According to the Examiner, the cited disclosure in Perez of a prescriber correcting and re-submitting a corrected transaction is considered to disclose creating a modified electronic prescription transaction (Ans. 6).

We agree with the Appellants.

Here, the argued claim limitation requires "[5] editing the electronic prescription transaction by performing, *by the one or more switch provider computers* . . . based at least in part on the stored logic [in the one or more switch provider computers] . . . correcting an error" (emphasis added). Thus, claim 1 requires that the switch provider computer, using the logic stored therein at step [1], performs the claimed function of correcting an error. The above citations to Perez fail to disclose this. Although Perez at paragraph 137 discloses a pharmacy-network-exchange finding a discrepancy (error) in an electronic prescription and returning a message back to the ordering prescriber, and that the prescriber can then correct and

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re-submit the corrected prescription to the pharmacy-network-exchange, Perez does not disclose that the correction is performed by the pharmacy-network-exchange based on logic stored therein as required by claim 1.

For these reasons, the rejection of claim 1 and its dependent claims is not sustained. The remaining claims contain a similar limitation, and the rejection of these claims is not sustained for the same reasons given above.

CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 101.

We conclude that the Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a) as listed in the rejections section above.

DECISION

The Examiner's rejection of claims 1–5, 7–13, and 15–25 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED